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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,466	01/25/2001	Toshiyuki Takao	FF-0131US	3951
21254	7590	09/07/2005	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			ZHOU, TING	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,466

Applicant(s)

TAKAO ET AL.

Examiner

Ting Zhou

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13-18 and 20-35 is/are rejected.
- 7) ☒ Claim(s) 5, 12 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

19

DETAILED ACTION

1. The Request for Continued Examination (RCE) filed on 23 June 2005 under 37 CFR 1.53(d) based on parent Application No. 09/768,466 is acceptable and a RCE has been established. An action on the RCE follows.
2. The amendments filed on 31 May 2005, submitted with the filing of the RCE have been received and entered. Claims 1-35 as amended are pending in the application.
3. It is noted that at the present time, the applicant has declined to write allowable dependent claims 5, 12 and 19 in independent form, as suggested by the examiner in the previous office actions dated 19 April 2004, 6 December 2004 and 24 March 2005.

Allowable Subject Matter

4. Claims 5, 12 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. The following is an examiner's statement of reasons for allowance: The present invention teaches the creation of an operation screen. Each of claims 5, 12 and 19 identifies the distinct feature of conducting the automatic positioning setting process when the paste-up information is moved to the amount of a predetermined ratio in a predetermined position on the operation screen in which the paste-up information is to be pasted. The closest prior art, Cannon et al.

Art Unit: 2173

(U.S. Patent 5,748,484) and Microsoft® Word 2000, (Screenshots 1-8) teach an automatic positioning setting process that is capable of editing the position and size of the information pasting region. In the case of the Cannon et al. reference, Cannon et al. teach an automatic positioning setting process for coinciding a barycenter of paste-up information with a predetermined point on the operation screen (automatically positioning the signature or picture in a specified position relative to the rest of the card) (Cannon et al.: column 12, lines 32-40). In the case of the Microsoft Word reference, Microsoft Word teaches editing a position and size of the information pasting region (the pictures toolbar allows users to edit information such as the size, via the crop tool, of the information pasting region, i.e. the pasted image) (Microsoft Word: Screenshot 3). However, the prior art of record fails to explicitly teach the automatic positioning setting process is conducted when the paste-up information is moved to the amount of a predetermined ratio in a predetermined position on the operation screen in which the paste-up information is to be pasted, and thus fails to anticipate or render the above limitations obvious.

Each of claims

6. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-11, 13-18 and 20-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon et al. U.S. Patent 5,748,484 and Microsoft® Word 2000, copyright 1999 (Screenshots 1-8).

Referring to claims 1, 8 and 15, Cannon et al. teach a system, method and recording medium (card display/order and printing computer system) storing a program including instructions for performing a method comprising a paste-up information receiving unit for receiving paste-up information to paste on information pasting regions on the operation screen (receiving images to position at information pasting regions such as the center of the panel "C", top of the panel "T", etc.) (Cannon et al.: column 4, lines 55-58 and column 11, line 63 – column 12, line 31), a paste-up information setting unit (to personalize the card) for setting the position and size of the paste-up information to be pasted on the information pasting regions on the operation screen (positioning text on the card by setting the font size, and position, such as center of the panel "C", top of the panel "T", etc. of the text to be added) (Cannon et al.: column 11, lines 58 - column 12, line 23), a barycenter of paste-up information coinciding with a predetermined point on the operation screen (for example, the image can be positioned at the center of the panel and therefore, a barycenter, or point of the image to be pasted must coincide with the predetermined point, or center of the display screen) (Cannon et al.: column 11, lines

Art Unit: 2173

62-67 and column 12, lines 1-23), and an operation screen creating unit for creating a new operation screen according to the results of the setting unit (card display system and printing system that allows users to view the cards created) (Cannon et al.: column 5, lines 64-67 and column 6, lines 1-4), wherein the operation screen is a control terminal which controls a remote terminal (printer) via a communication line (telecommunications link) (Cannon et al.: column 5, lines 23-29, 52-56 and 64-67), and wherein the paste-up information is pasted on the information pasting regions based on a relative position and size of the information pasting regions (positioning, i.e. pasting the signature or picture in a specified position relative to the rest of the card, and pasting the image onto the defined area, i.e. the information pasting region, based on the size of the defined area) (Cannon et al.: column 8, lines 58-67 and column 11, line 46 – column 12, line 40). However, Cannon et al. fail to explicitly teach the operation screen creating unit comprising an editing device for editing at least one of a position and size of the information pasting regions to create the operation screen for controlling the remote terminal. Microsoft Word teaches a screen creation interface that receives and sets the position and size, and pastes information on the display screen to create the screen display (pasting information such as an image on the screen in a certain position) (Microsoft Word: Screenshot 2) similar to that of Cannon et al. In addition, Microsoft Word further teaches an editing device for editing at least one of a position and size of the information pasting regions to create an operation screen (the toolbar allows users to edit information such as the size, via the crop tool, of the information pasting region, i.e. the pasted image) (Microsoft Word: Screenshot 3). It would have been obvious to one of ordinary skill in the art, having the teachings of Cannon et al. and Microsoft Word before him at the time the invention was made, to modify the operation screen creating

Art Unit: 2173

unit for controlling a remote terminal taught by Cannon et al. to include the editing device of Microsoft Word. One would have been motivated to make such a combination in order to provide easy-to-use, changeable onscreen operating instructions that allow users to continuously build his image in real time to his own particular desires and specification; furthermore, it would have been advantageous to make such a combination because it allows editing at each step of the creation process, ensuring that the final product will meet the user's criteria.

Referring to claims 2, 9 and 16, Cannon et al. teach the paste-up information receiving unit including at least one of an image data reading unit for receiving image data and a text data receiving unit for receiving text data, as recited in column 4, lines 60-62.

Referring to claims 3, 10 and 17, Cannon et al. teach an external memory device in communication with the control terminal (card display/order system), wherein the paste-up information from a file recorded in the external memory device (image files stored in data storage units such as CD-ROM), as recited in column 5, lines 23-29 and column 13, lines 55-57.

Referring to claims 4, 11 and 18, Cannon et al. teach the paste-up information setting unit undertaking an automatic positioning setting process (automatically placing a signature or picture of the card purchaser) for coinciding a barycenter of paste-up information with a predetermined point on the operation screen (positioning the signature or picture in a specified position relative to the rest of the card; therefore, a point or position of the picture or signature need to be placed on, or coincide with a positional point on the display screen), as recited in column 12, lines 32-40. Furthermore, according to the specification of the application on page 11, lines 31-32 and continuing onto page 12, lines 1-11, the automatic positioning setting process automatically alters the size of the paste-up information in order to fit it in the paste-up

Art Unit: 2173

information region. Cannon et al. teach the resizing of the received images so it will fit within a defined area, as recited in column 8, lines 58-68.

Referring to claims 6, 13 and 20, Cannon et al. teach the operation screen creating unit creating a plurality of the operation screens (a plurality of cards), having different designs based on a common setting value relating to a position, size and direction of the paste-up information (different designs for the cards but uses a common image such as a logo), as recited in column 7, lines 66-67 and column 8, lines 1-7.

Referring to claims 7, 14 and 21, Cannon et al. teach the control terminal (system for ordering and printing social expression cards) comprising a plurality of control terminals (database preparation system, card display/order facilities and card printing facilities), as recited in column 4, lines 52-58. The system, method and recording medium further comprises a paste-up information storing unit connected to the communication line, communicating with a plurality of control terminals (column 5, lines 23-29) for storing a setting value relating to the position, size and direction of the paste-up information and wherein the operation screen is updated in accordance with the setting values of the paste-up information stored in the storing unit (column 11, lines 62-67).

Referring to claim 22, Cannon et al. teach a display device operably connected to a control terminal connected to a communication line for displaying an operation screen (Cannon et al.: column 5, lines 33-38), a paste-up information section and a screen arrangement section (used to personalize the card) having an input side connected to the information section and an output side connected to the display device (the inputs are received from the users regarding the desired characteristics of the card designs and outputted on the display screen) (Cannon et al.:

Art Unit: 2173

column 5, lines 32-39 and Figures 1 and 3), wherein the screen arrangement section is being operated by a user to automatically coincide a barycenter of inputted paste-up information with a predetermined point (automatically placing a signature or picture of the card purchaser by positioning the signature or picture in a specified position relative to the rest of the card; therefore, a point or position of the picture or signature need to be placed on, or coincide with a positional point on the display screen) (Cannon et al.: column 12, lines 32-40), and wherein the paste-up information is pasted on the information pasting regions based on a relative position and size of the information pasting regions (positioning, i.e. pasting the signature or picture in a specified position relative to the rest of the card, and pasting the image onto the defined area, i.e. the information pasting region, based on the size of the defined area) (Cannon et al.: column 8, lines 58-67 and column 11, line 46 – column 12, line 40). This is further recited in column 5, lines 57-67 and continuing onto column 6, lines 1-4. However, Cannon et al. fail to explicitly teach the screen arrangement section comprising an editing device for editing at least one of a position and size of the information pasting regions to create the operation screen for controlling the remote terminal. Microsoft Word teaches a screen creation interface that receives and sets the position and size, and pastes information on the display screen to create the screen display (pasting information such as an image on the screen in a certain position) (Microsoft Word: Screenshot 2) similar to that of Cannon et al. In addition, Microsoft Word further teaches an editing device for editing at least one of a position and size of the information pasting regions to create an operation screen (the toolbar allows users to edit information such as the size, via the crop tool, of the information pasting region, i.e. the pasted image) (Microsoft Word: Screenshot 3). It would have been obvious to one of ordinary skill in the art, having the teachings of

Art Unit: 2173

Cannon et al. and Microsoft Word before him at the time the invention was made, to modify the operation screen creating unit for controlling a remote terminal taught by Cannon et al. to include the editing device of Microsoft Word. One would have been motivated to make such a combination in order to provide easy-to-use, changeable onscreen operating instructions that allow users to continuously build his image in real time to his own particular desires and specification; furthermore, it would have been advantageous to make such a combination because it allows editing at each step of the creation process, ensuring that the final product will meet the user's criteria.

Referring to claim 23, Cannon et al. teach the remote terminal comprising a printer, as recited in column 5, lines 33-38 and 52-56.

Referring to claim 24, Cannon et al. teach the operation screen (card display facility) located at the control terminal (the card display facility controls the appearance of the card and then sends the finished card to a remote printer terminal to be printed), as recited in column 5, lines 33-38.

Referring to claim 25, Cannon et al. teach a display device connected to the control terminal and displaying the operation screen, as shown in Figures 1 and 18 and recited in column 22, lines 61-67 and column 23, lines 1-17.

Referring to claim 26, Cannon et al. teach the remote terminal comprising a plurality of remote terminals, as recited in column 5, lines 23-29 and 39-43. This is further shown in Figure 18.

Referring to claims 27 and 32, Cannon et al. teach a tool and method comprising a memory device which stores information to be displayed in the operation screen for operating a

Art Unit: 2173

remote printer (the databases and image files are stored in a data storage unit to be displayed on the card display/order system and printed from the card printing system) (Cannon et al.: column 5, lines 23 – column 6, line 4) and a processor which causes a display device to display preset information pasting regions on a background screen, and causes the information to be displayed on the preset information pasting regions (the page, or panel used for image placement displays images on information pasting regions on the displayed page, or panel, such as the center of the panel “C”, top of the panel “T”, etc.) (Cannon et al.: column 11, line 46 – column 12, line 40), and wherein the paste-up information is pasted on the information pasting regions based on a relative position and size of the information pasting regions (positioning, i.e. pasting the signature or picture in a specified position relative to the rest of the card, and pasting the image onto the defined area, i.e. the information pasting region based, on the size of the defined area) (Cannon et al.: column 8, lines 58-67 and column 11, line 46 – column 12, line 40). However, Cannon et al. fail to explicitly teach an editing device for editing at least one of a position and size of the preset information pasting regions to create the operation screen for operating a remote printer. Microsoft Word teaches a screen creation interface that receives and sets the position and size, and pastes information on the display screen to create the screen display (pasting information such as an image on the screen in a certain position) (Microsoft Word: Screenshot 2) similar to that of Cannon et al. In addition, Microsoft Word further teaches an editing device for editing at least one of a position and size of the information pasting regions to create an operation screen (the toolbar allows users to edit information such as the size, via the crop tool, of the information pasting region, i.e. the pasted image) (Microsoft Word: Screenshot 3). It would have been obvious to one of ordinary skill in the art, having the teachings of

Art Unit: 2173

Cannon et al. and Microsoft Word before him at the time the invention was made, to modify the operation screen creating unit for controlling a remote terminal taught by Cannon et al. to include the editing device of Microsoft Word. One would have been motivated to make such a combination in order to provide easy-to-use, changeable onscreen operating instructions that allow users to continuously build his image in real time to his own particular desires and specification; furthermore, it would have been advantageous to make such a combination because it allows editing at each step of the creation process, ensuring that the final product will meet the user's criteria.

Referring to claims 28 and 33, Cannon et al., as modified, teach the operation screen comprises a background screen and the information paste-up regions comprise outlined areas displayed on the background screen (as shown in Screenshot 6, an outlined text box area is displayed on the background screen for receiving paste-up information such as pasted text).

Referring to claims 29 and 34, Cannon et al., as modified, teach erasing the outlined areas from the operation screen when the information is ready to be pasted (users can erase the outlined text box via selection of the "Clear" command when the users are ready to paste information on the screen, as shown in Screenshots 7-8).

Referring to claims 30 and 35, Cannon et al. as modified, teach the operation screen creating unit causes a size of the information to be altered one of automatically based on a size of the information past-up regions and based on a user input (upon user input such as a click and drag operation of the user's pointing device, a size of the information, or image can be altered, as shown in Screenshots 4-5).

Referring to claim 31, Cannon et al., as modified, teach the editing device comprises one of an automatic editing device which automatically edits a position and size of the information paste-up regions and a user-operated editing device which edits a position and size of the information paste-up regions according to a user operation (user operated editing of pasted images as shown in Screenshots 4-5; for example, upon user input such as a click and drag operation of the user's pointing device, a size of the information, or image can be altered, as shown in Screenshots 4-5).

Response to Arguments

8. Applicant's arguments filed 31 May 2005 have been fully considered but they are not persuasive:

9. The applicant argues that the Cannon and Microsoft Word references are completely unrelated and would not have been combined. The examiner respectfully disagrees. Cannon teaches an interface for creation of a screen display, i.e. creating a personalized card that is displayed via user selected position and size information of the pasted image, as recited in column 5, lines 29-38 and column 11, line 62-column 12, line 40. Similarly, Microsoft Word also teaches an interface that receives user specification of a position and size of an image to be pasted and creates a corresponding screen display with the pasted image, as shown in Screenshot 2. Therefore, both Cannon and Microsoft Word teach related interfaces for pasting images and thereby personalizing a displayed screen. Further, the applicant argues that there is no motivation or suggestion in the references to urge the combination. The examiner respectfully

Art Unit: 2173

disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Cannon implies editing capabilities with the teaching of an Edit menu on column 9, lines 1-21. Although Cannon does not explicitly teach an editing device for editing at least one of position and size of the information pasting regions, the interface taught by Cannon does allow for editing operations via teachings of the Edit menu; therefore, it would have been obvious for one of ordinary skill in the art to modify the interface of Cannon to include the editing device of Microsoft Word. Furthermore, the teaching of an editing device for editing position and size information is generally known to one of ordinary skill in art for allowing users to personalize and build his or her display to meet required or desired specifications and criteria.

10. In addition, the applicant argues that neither Cannon, Microsoft Word, nor any combination thereof teaches or suggests "wherein said paste-up information is pasted on said information pasting regions based on a relative position and size of said information pasting regions". The examiner respectfully disagrees. Cannon teaches positioning, i.e. pasting the signature or picture in a specified position relative to the rest of the card and in a specified size, i.e. text font and point size (column 11, line 46 – column 12, line 40) based on the size of the defined area (i.e. if the image is larger than the defined area, or the information pasting region,

Art Unit: 2173

the image is reduced to the size of the area, as recited in column 8, lines 58-67); specifically, on column 12, lines 32-40, Cannon teaches that images can be “positioned in a specified relationship to other card components, for example, a personalized image 73 may be positioned one quarter of an inch below a text area”; therefore, an image is placed at a relative position to the card and other card components. Furthermore, the applicant argues that Cannon may address where an image is to be positioned on the card, but nowhere does Cannon address how or where the image is to be placed on the display screen. The examiner respectfully points out that the operation screen of Cannon is the displayed card interface which allows personalization; for example, images are positioned and sized onto the card which is displayed on the screen to allow personalization, as recited in column 5, line 64-column 6, line 4 and column 11, line 62-column 12, line 40.

11. Furthermore, the applicant argues that the created screen of Cannon would be a “result screen” and not an “operation screen” because Cannon is not concerned with an “operation screen”. The examiner respectfully disagrees. Cannon teaches the creation and display of a card on the screen based on operations of the user, such as selecting the position and size of images that are correspondingly pasted onto the card/screen (column 5, line 64-column 6, line 4 and column 11, line 62-column 12, line 40); therefore, the screen displaying the card of Cannon is an operation screen, since the card displayed allows user operations (such as pasting images) and is based on user operations (such as the user selected position of the pasted image).

12. Lastly, the applicant argues that it is unreasonable to imply that the image in screenshot 3 of Microsoft Word is both a “pasted image” and an “information pasting region”. The examiner respectfully disagrees. Screenshot 2 shows an image (i.e. a star) is pasted onto a region of the display region, i.e. the information pasting region; as further shown, the star image is pasted onto the boxed region in Screenshot 3. In addition, Microsoft Word teaches that the pasted star image, and therefore, the boxed information pasting region can be edited/resized (i.e. cropped or enlarged), as shown in Screenshots 3 and 4.

13. In view of the above, the examiner respectfully maintains that combinations of Cannon and Microsoft Word teach the subject claims.

Conclusion

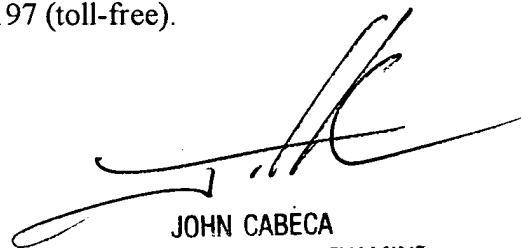
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2173

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